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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,165	12/15/2003	Martin J. Dowling	I-2-0585.IUS	4418

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EXAMINER

BALAOING, ARIEL A

ART UNIT PAPER NUMBER

2617

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/736,165

Applicant(s)

DOWLING, MARTIN J.

Examiner

Ariel Balaoing

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-9,11-14 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-14 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07-20-2006 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-9, 11-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

3. Claim 14 is objected to because of the following informalities: the claim recites the limitation "a second communications transceiver" on line 5 of the claim. However the limitation is referred to as "the local radio link second communications transceiver" on line 7 and 8. The claim language should be claimed identically when referring to a previously written limitation. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2, 4-7, 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "a predetermined signal" on line 4-5 and line 11 of the claim. It is unclear as to whether this limitation refers to the same signal or a first and second signal.

6. Claims 2, 4-7 recite the limitation "the local radio link transmitter". There is insufficient antecedent basis for this limitation in the claim.

7. Claims 22-24 recites the limitation "the received antenna" in claim 22. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by KITA (US 5,960,367).

Regarding claim 14, KITA discloses a wireless transmit receive unit comprising: a first communications transceiver configured to communicate with a wireless network in accordance with network protocols (**21, 21a**; abstract); a second communication transceiver **24** configured to communicate with at least one remote communication unit **26, 27** (abstract; col. 2, line 28-56); circuitry configured to selectively transmit data through the local radio link second communications transceiver concerning an alert other than a telephone call, and to communicate the alert to the at least one remote communication unit (abstract; col. 25, line 45-col. 26, line 14; notification of position entry request as well as incoming alert. Furthermore it is noted that various forms of notification other than a telephone call alert can be provided from mobile devices).

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1, 2, 4-9, 11, 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN (US 6,119,022) in view of BACH et al (US 6,377,795 B1).

Regarding claim 1, OSBORN discloses a silent alerting system comprising: a wearable device (16-Figure 1; column 4:lines 31-45) comprising: a vibrator (column 6:lines 49-60); a receiver that activates the vibrator upon receiving a predetermined signal (abstract; column 5:lines 5-36; column 6:lines 49-60); a power supply that powers the vibrator and receiver (column 5:lines 5-36); and a communication device (10, 14-Figure 1) comprising: a transceiver **23** to link to a wireless network (column 4:lines 31-45); a classification device to classify incoming calls based on information from a

database (column 6:lines 35-48); and a signaling device to silence said communication device, record a message, and send the predetermined signal according to the call classification to said receiver upon receipt of said call (column 6:line 35-column 7:line 43; calls are classified according to user indication of call numbers within a memory [database] of the device). However, OSBORN does not expressly teach a classifying device classifying an incoming call based on a caller response to a query and configured to determine whether or not to transmit a predetermined signal based upon the call classification; and selectively transmitting the predetermined signal according to the call classification. BACH discloses a classifying device classifying an incoming call based on a caller response to a query (column 2:line 54-column 3:line 26; BACH allows the call the ability to be classified as urgent, important or routine) and configured to determine whether or not to transmit a predetermined signal based upon the call classification (Figure 3; col. 4, line 15-42; call is rejected unless number is an accepted programmed number); and selectively transmitting the predetermined signal according to the call classification (Figure 3; col. 4, line 15-42; call notification selectively chosen by database entry). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as taught by BACH, since BACH teaches on col. 1, line 25-35 that such a modification would allow a user to keep a cellular device on without disturbing a meeting when a call is received.

Regarding claim 2, OSBORN discloses a wireless transmit/receive unit (WTRU) comprising: a first communications transceiver configured to communicate with a

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wireless network in accordance with network protocols (column 4:lines 15-45; as a cell phone in used in the specification, the device inherently includes a means for communicating with a wireless network in accordance with a network protocol); a second communications transceiver, receivable by a remote signaling unit, for providing a user with an indication of an incoming call (column 7:lines 5-53); circuitry to classify an incoming call based on information from a database (column 6:lines 35-48; calls are classified according to user indication of call numbers within a memory [database] of the device); and circuitry to transmit data through the local radio link transmitter concerning calls in accordance with the call class (column 6:lines 35-48). However, OSBORN does not expressly teach classifying an incoming call based on a caller response to a query and selectively transmitting data in accordance to call class. BACH discloses classifying an incoming call based on a caller response to a query (column 2:line 54-column 3:line 26; BACH allows the call the ability to be classified as urgent, important or routine) and selectively transmitting data in accordance to call class (Figure 3; col. 4, line 15-42; call notification selectively chosen by database entry). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as taught by BACH, since BACH teaches on col. 1, line 25-35 that such a modification would allow a user to keep a cellular device on without disturbing a meeting when a call is received.

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising the

local radio link transmitter further providing caller identification data for display on the remote signaling unit (column 6:lines 19-35).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising the local radio link transmitter provided as part of a transceiver, thereby permitting the user to communicate through the WTRU by use of the local radio link (column 5:line 5-column 6:line 4).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses wherein the WTRU using CLID data in said discrimination between classes of incoming calls (column 6:line 20-48). However, OSBORN does not disclose wherein the WTRU includes a circuit which uses a caller response in said discrimination between classes of incoming calls. BACH discloses wherein the WTRU includes a circuit which uses a caller response in said discrimination between classes of incoming calls (column 2:line 54-column 3:line 26). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as taught by BACH, as this allows the user notification of a call with urgent priority status.

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising: the local radio transmitter provided a transceiver for providing communication with one or more remote communication units (column 5:line 36-column 6:line 4; column 7:lines 5-



43); and circuitry to transmit data through the local radio link transceiver concerning calls, and to communicate with at least one of the remote communication units, thereby providing simultaneous communication between a wireless network connection and plural ones of the remote communication units (column 5:line 36-column 6:line 4; column 7:lines 5-43).

Regarding claim 8, OSBORN discloses a wearable device comprising: a receiver to receive and respond to transmissions from a local wireless phone when said phone is called, the response being according to a call class based on information from a database (column 5:line 36-column 6:line 4; column 7:lines 5-43; calls are classified according to user indication of call numbers within a memory [database] of the device); a vibrator that is actuated when said receiver receives said transmission (abstract; column 5:lines 5-36; column 6:lines 49-60); and a battery to power said receiver and said vibrator, whereby a user is alerted by said vibrator according to the call class when said phone is called (column 5:lines 5-36). However, OSBORN does not expressly teach a receiver configured to selectively receive transmissions and classifying an incoming call based on a caller response to a query. BACH discloses a receiver configured to selectively receive transmissions and classifying an incoming call based on a caller response to a query (Figure 3; col. 4, line 15-42; call notification selectively chosen by database entry; column 2:line 54-column 3:line 26; BACH allows the call the ability to be classified as urgent, important or routine). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as

taught by BACH, since BACH teaches on col. 1, line 25-35 that such a modification would allow a user to keep a cellular device on without disturbing a meeting when a call is received.

Regarding claim 9, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses additionally comprising an attachment device to attach said wearable device in such a way as to maintain it in contact with said user's body (16-Figure 1, 3, 4; column 4:lines 31-45).

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses further comprising an alpha-numeric display, whereby the caller's ID can be displayed (50-Figure 3, 4; column 6:lines 19-35).

Regarding claim 22, OSBORN discloses a method for remote alerting in a wireless communication system comprising a plurality of wireless transmit/receive units, the method comprising: a first WTRU receiving, on a first transceiver, a signal intended for a second WTRU (column 4:lines 31-45); a first WTRU performing a signal classification on the received antenna based upon a database (column 6:line 35-column 7:line 43); the first WTRU transmitting, on a second transceiver, an alert signal to the second WTRU (column 6:line 35-column 7:line 43); and the second WTRU receiving the alert signal and selectively alerting a wearer of the second WTRU (column 6:line 35-column 7:line 43); and the second WTRU selectively transmitting a response to the first WTRU (column 6:line 35-column 7:line 43). However, OSBORN does not expressly disclose performing a signal classification on a caller response to a query; and

selectively transmitting an alert signal to the second WTRU. BACH discloses performing a signal classification on a caller response to a query (column 2:line 54-column 3:line 26; BACH allows the call the ability to be classified as urgent, important or routine); and selectively transmitting an alert signal to the second WTRU (Figure 3; col. 4, line 15-42; call notification selectively chosen by database entry). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify OSBORN to include a caller response when discriminating between calls, as taught by BACH, since BACH teaches on col. 1, line 25-35 that such a modification would allow a user to keep a cellular device on without disturbing a meeting when a call is received.

Regarding claim 23, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. OSBORN further discloses wherein the database resides in the first WTRU (col. 6, line 36-48).

12. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN (US 6,119,022) in view of BACH et al (US 6,377,795 B1) and further in view of CAZIER (US 2004/0100505 A1).

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependent upon regarding the subject matter this claim is dependent upon. OSBORN further discloses further comprising: an alpha-numeric display, whereby the caller's ID can be displayed (50-Figure 3, 4; column 6:lines 19-35); and a menu function control in communication with the local wireless phone; and a two-way

voice communications capability with the local wireless phone, thereby permitting a user to communicate through the local wireless phone by use of the wearable device (column 5:line 5-column 6:line 4). However, the combination of OSBORN and BACH does not disclose a menu function control in communication with the local wireless phone. CAZIER discloses a menu function control in communication with the local wireless phone (paragraph 9, 24). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of OSBORN and BACH to provide a menu control on the remote device in communication with the local phone, as taught by CAZIER, as the use of a menu functions within electronic device to control various functions is well known in the art.

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependent upon regarding the subject matter this claim is dependent upon. OSBORN further discloses comprising: an alpha-numeric display, whereby the caller's ID can be displayed (50-Figure 3, 4; column 6:lines 19-35); and a two-way voice communications capability with the local wireless phone using a shared channel, thereby permitting one or more users to simultaneously communicate through the local wireless phone by use of the wearable device (column 5:line 5-column 6:line 4). However, the combination of OSBORN and BACH does not disclose a menu function control in communication with the local wireless phone. CAZIER discloses a menu function control in communication with the local wireless phone (paragraph 9, 24). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of OSBORN and BACH to provide a

menu control on the remote device in communication with the local phone, as taught by CAZIER, as the use of a menu functions within electronic device to control various functions is well known in the art.

13. Claims 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over OSBORN (US 6,119,022) in view of BACH et al (US 6,377,795 B1) as applied to claim 22 above, and further in view of BURGESS (US 2002/0128033 A1).

Regarding claim 24, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, the combination of OSBORN and BACH does not disclose wherein the database resides in a radio network controller. BURGESS discloses wherein the database resides in a radio network controller (paragraphs 23-25, 50, 65-68). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made modify the combination of OSBORN and BACH to include the database on a radio network, as taught by BURGESS, as this allows the mobile device to reduce the memory needed for operation. Also, it has been well established in the art of caller identification to provide a database of callers from either a wireless electronic device (such as an address book) or within a radio network (HLR/VLR/MS).

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PINDER et al (US 6,701,160 B1) – Method and apparatus to locally block incoming selected calls

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**JEAN GELIN**  
**PRIMARY EXAMINER**

AB



Ariel Balaoing – Art Unit 2617

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